



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,104	11/15/2000	Eiichi Sato	B422-143	9652

26272 7590 06/17/2005

COWAN LIEBOWITZ & LATMAN P.C.
JOHN J TORRENTE
1133 AVE OF THE AMERICAS
1133 AVE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

MOORTHY, ARAVIND K

ART UNIT PAPER NUMBER

2131

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/713,104

Applicant(s)

SATO, EIICHI

Examiner

Aravind K. Moorthy

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,8-10 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6,8-10 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the amendment filed on 5 May 2005.
2. Claims 1, 6, 8-10 and 21-24 are pending in the application.
3. Claims 1, 6, 8-10 and 21-24 have been rejected.
4. Claims 2-5, 7 and 11-20 have been cancelled.

Continued Examination Under 37 CFR 1.114

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5 May 2005 has been entered.

Response to Arguments

6. Applicant's arguments with respect to claims 1, 6 and 8-10 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 6, 8-10 and 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The second discrimination means is unclear to the examiner. As recited, "second discrimination means for discriminating if the terminal of an address of the received data",

appears to be an incomplete step. For the sake of examining, the examiner assumes that the second discrimination means is discriminating if the address corresponds to stored address.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 6, 9, 10, 21 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Leeds U.S. Patent No. 6,393,465 B2.

As to claim 1, Leeds discloses a communication apparatus for transferring data from a first network to a second network [column 3, lines 9-36], the apparatus comprising:

first discrimination means for discriminating if the received data is a confidential data [column 4, lines 24-35];

second discrimination means for discriminating if the terminal of an address of the received data corresponds to a stored address [column 4, lines 36-59];

control means for controlling to provide the terminal with the received data by using either a method of transferring the received data attached with E-mail to the terminal, a method of encrypting the received data and transferring the encrypting data attached with E-mail to the terminal or a method of storing the received data in a predetermined memory and transferring information to be used

Art Unit: 2131

for access to the stored received data attached with E-mail to the terminal to in accordance with the result of the discrimination by the first discrimination means and the second discrimination means [column 6 line 66 to column 7 line 51].

As to claims 6, 21 and 23, Leeds discloses an apparatus further comprising:

management means for managing encryption information correlated to the terminal [column 7 line 52 to column 8 line 20]; and

third discrimination means for discriminating if the encryption information correlated with the terminal is managed by the management means [column 7 line 52 to column 8 line 20],

wherein the control means controls a method of providing the terminal with the received data in accordance with the discrimination results [column 7 line 52 to column 8 line 20].

As to claim 9, Leeds discloses a communication method of transferring data from a first network to a second network [column 3, lines 9-36], the method comprising:

first discrimination means for discriminating if the received data is a confidential data [column 4, lines 24-35];

second discrimination means for discriminating if the terminal of an address of the received data corresponds to a stored address [column 4, lines 36-59];

control means for controlling to provide the terminal with the received data by using either a method of transferring the received data attached with E-mail to the terminal, a method of encrypting the received data and transferring

the encrypting data attached with E-mail to the terminal or a method of storing the received data in a predetermined memory and transferring information to be used for access to the stored received data attached with E-mail to the terminal to in accordance with the result of the discrimination by the first discrimination means and the second discrimination means [column 6 line 66 to column 7 line 51].

As to claim 10, Leeds discloses a computer readable memory medium storing a program of a communication method of transferring data from a first network to a second network [column 3, lines 9-36], the apparatus comprising:

first discrimination means for discriminating if the received data is a confidential data [column 4, lines 24-35];

second discrimination means for discriminating if the terminal of an address of the received data corresponds to a stored address [column 4, lines 36-59];

control means for controlling to provide the terminal with the received data by using either a method of transferring the received data attached with E-mail to the terminal, a method of encrypting the received data and transferring the encrypting data attached with E-mail to the terminal or a method of storing the received data in a predetermined memory and transferring information to be used for access to the stored received data attached with E-mail to the terminal to in accordance with the result of the discrimination by the first discrimination means and the second discrimination means [column 6 line 66 to column 7 line 51].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8, 22 and 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leeds U.S. Patent No. 6,393,465 B2 as applied to claims 1, 9 and 10 above, and further in view of Perlman U.S. Patent No. 6,363,480 B1.

As to claims 8, 22 and 24, Leeds does not teach management means for managing the encryption information and an effective period of the encryption information correlated with the terminal. Leeds does not teach discrimination means for discriminating the effective period of the encryption information and if the encryption information correlated with the terminal which is a destination of the received data is managed by the management means. Leeds does not teach that the control means controls a method of providing the received data in accordance with the discrimination results.

Perlman teaches management means for managing the encryption information and an effective period of the encryption information correlated with the terminal [column 6 line 58 to column 7 line 8]. Perlman teaches discrimination means for discriminating the effective period of the encryption information and if the encryption information correlated with the terminal which is a destination of the received data is managed by the management means [column 6 line 58 to column 7 line 8]. Perlman teaches that the control means controls a method of providing

Art Unit: 2131

the received data in accordance with the discrimination results [column 6 line 58 to column 7 line 8].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Leeds so that the destination information in the header would have included encryption information corresponding to the destination was within an effective period. The management system would have determined if the encrypted information correlates with the effective period and if the encrypted information was received by the appropriate destination. The means of providing the information would have been in accordance with the determination of the effective period.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Leeds by the teaching of Perlman, as described above, because it permits selection of an appropriate decryptability lifetime for specific units of data, such as electronic mail messages. Further, where one or more third party ephemerizer systems are used to provide ephemeral keys to encrypt a message, such third party ephemerizers may be employed to destroy the ephemeral keys at their expiration times, without burdening the communicating parties with this responsibility [column 4, lines 18-27].

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aravind K Moorthy *AM*
June 2, 2005

Shin
06/03/05